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EXAMINER	
DURAN, ARTHUR D	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/851,518	MATSUKAWA, YUKIHIRO	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 May 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Claims 1-8 have been examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 4, 8 are rejected under 35 U.S.C. 102(e) as being unpatentable over Hunter (6,647,417).

Claim 1, 2: Hunter discloses an advertisement distribution system comprising:

a storage means for storing, as distribution data in a plurality of types, both or one of music data including a specific musical piece combined with an advertising message and image data including a specific image combined with at least one of an advertising image and an advertising message, and

a transmission means for transmitting the type of the distribution data stored in the storage means to a user terminal via a predetermined communication line, and at the request of a user inputted from the user terminal via the communication line, extracting the distribution data selected by the user from the storage means to transmit to the user terminal via the communication line (col 13, lines 54-col 14, line 5; Fig. 13).

Hunter further discloses that the advertisement distribution system as set forth in claim 1, wherein said music data or image data are constituted such that said advertising message or advertising image is disposed at least one of just before and after the specific musical piece or specific image, respectively (col 13, lines 54-col 14, line 5; Fig. 13).

Claim 4: Hunter further discloses that the advertisement distribution system as set forth in claim 1, wherein said advertising message or advertising image can be separated from said specific musical piece or specific image, respectively (col 13, lines 62-66).

Claim 8: Hunter discloses the advertisement distribution system as set forth in claim 1 further comprising:

a detection means for detecting positional information of said user terminal,

wherein said transmission means transmits the type and an acquisition method of the distribution data to the user terminal detected by the detection means, and then, to the user terminal requesting acquisition of the distribution data according to the acquisition method, transmits the distribution data on a predetermined condition (col 20, lines 60-65; col 6, lines 30-60; Fig. 1).

Hunter further discloses that the predetermined condition can be that the satellite receivers be customers (col 20, lines 60-65), that the transmission means, acquisition method, and position of the user are known (col 6, lines 30-60).

3. Claims 1, 2, 4 are rejected under 35 U.S.C. 102(e) as being unpatentable over Parrella (6,507,764).

Claim 1, 2: Parrella discloses an advertisement distribution system comprising a storage means for storing, as distribution data in a plurality of types, both or one of music data including a specific musical piece combined with an advertising message and image data including a specific image combined with at least one of an advertising image and an advertising message, and

a transmission means for transmitting the type of the distribution data stored in the storage means to a user terminal via a predetermined communication line, and at the request of a user inputted from the user terminal via the communication line, extracting the distribution data selected by the user from the storage means to transmit to the user terminal via the communication line (col 3, lines 35-56; col 1, lines 5-17; col 1, lines 45-60; col 5, lines 10-41).

Parrella further discloses that the advertisement distribution system as set forth in claim 1, wherein said music data or image data are constituted such that said advertising message or advertising image is disposed at least one of just before and after the specific musical piece or specific image, respectively (col 3, lines 35-56; col 1, lines 5-17; col 1, lines 45-60; col 5, lines 10-41).

Claim 4: Parrella further discloses that the advertisement distribution system as set forth in claim 1, wherein said advertising message or advertising image can be separated from said specific musical piece or specific image, respectively (col 3, lines 35-40).

4. Claim 1-4 are rejected under 35 U.S.C. 102(e) as being unpatentable over Fenner (6,243,328).

Claim 1, 2: Fenner discloses an advertisement distribution system comprising:

a storage means for storing, as distribution data in a plurality of types, both or one of music data including a specific musical piece combined with. an advertising message and image data including a specific image combined with at least one of an advertising image and an advertising message, and

a transmission means for transmitting the type of the distribution data stored in the storage means to a user terminal via a predetermined communication line, and at the request of a user inputted from the user terminal via the communication line, extracting the distribution data selected by the user from the storage means to transmit to the user terminal via the communication line (col 8, lines 57-65).

Fenner further discloses that the advertisement distribution system as set forth in claim 1, wherein said music data or image data are constituted such that said advertising message or advertising image is disposed at least one of just before and after the specific musical piece or specific image, respectively (col 8, lines 57-65).

Claim 3: Fenner discloses the advertisement distribution system as set forth in claim 1, wherein said music data or image data are digitized,

and constituted such that said advertising message or advertising image overlaps at least one of the first part and the last part of the specific musical piece or specific image, respectively (col 8, lines 57-65).

Claim 4: Fenner further discloses that the advertisement distribution system as set forth in claim 1, wherein said advertising message or advertising image can be separated from said specific musical piece or specific image, respectively (col 8, lines 57-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parrella (6,507,764) in view of Fenner (6,243,328).

Claim 3: Parrella discloses the system above. Parrella further discloses that music data or image data are digitized and that music, videos, audio advertisements, and video advertisements can be combined in any combination (col 3, lines 35-41).

Parrella does not explicitly disclose that the advertising can overlap the first or last part of the content.

Therefore, because Parrella discloses that advertisements and content can be combined in any combination, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Parrella's advertising can be combined with Parrella's content in a combination that has some overlapping. One would have been motivated to do this in order to attract more attention to the advertising.

Additonally, Fenner discloses the advertisement distribution system as set forth in claim 1, wherein said music data or image data are digitized,

and constituted such that said advertising message or advertising image overlaps at least one of the first part and the last part of the specific musical piece or specific image, respectively (col 8, lines 57-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add that Fenner's advertising overlapping with content to Parrella's combining advertising and content in any combination. One would have been motivated to do this in order to attract more attention to the advertising.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (6,647,417) in view of Fenner (6,243,328).

Claim 3: Hunter discloses the system above. Hunter further discloses that music data or image data are digitized (col 2, lines 10-16).

Hunter does not explicitly disclose that the advertising can overlap the first or last part of the content.

However, Fenner discloses that said music data or image data are digitized,

and constituted such that said advertising message or advertising image overlaps at least one of the first part and the last part of the specific musical piece or specific image, respectively (col 8, lines 57-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Fenner's advertising overlapping with content to Hunter's

combining advertising and content. One would have been motivated to do this in order to attract more attention to the advertising.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (6,647,417).

Claim 5: Hunter discloses the advertisement distribution system as set forth in claim 4.

Hunter further discloses that said advertising message or advertising image is automatically separated from said specific musical piece or specific image after said music data or image data have been played predetermined times (col 8, lines 30-35).

Hunter discloses that advertising and music can be downloaded to the user terminal (col 13, line 54-col 14, line 5). Hunter further implies that after purchase the advertisement is separated from the music content and discloses that the music is permanently recorded (col 13, line 63- col 14, line 1). Hunter further discloses that the information for payment can be sent upon listener listening to the music a preset number of times (col 8, lines 30-36). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hunter's separating the music from the advertisement upon user payment to Hunter's charging the user upon the user listening to the content a predetermined number of times. One would have been motivated to do this in order to allow users an appropriate amount of previews before charging the user for permanently owning the music.

8. Claims 6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (6,647,417) in view of Ansell (6,367,019).

Claim 6: Hunter discloses the advertisement distribution system as set forth in claim 5.

Hunter further implies that the intermediate content with advertising can be transferred or copied between user terminals (col 13, lines 60-col 14, line 5). Since Hunter's users can readily copy or transfer content between user terminals, it would be obvious to Hunter that the users can readily copy or transfer the promotional content that includes the advertisement between user terminals.

Additionally, Ansell discloses making content unplayable when content is copied or transferred from one user terminal to another user terminal (col 5, lines 39-46; col 8, lines 19-30; Fig. 6, Fig. 7).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ansell's making the content unplayable when an illegal copy is performed to Hunter's attempting to prevent illegal copying. One would have been motivated to do this in order to allow Hunter a further method of preventing illegal copying of content.

Claim 7: Hunter and Ansell disclose the advertisement distribution system as set forth in claim 6.

Hunter further discloses that said music data or image data are transferred or copied from said user terminal to another terminal, they are locked so that they cannot be played, and by entering a predetermined password transmitted from the advertisement distribution system on a predetermined condition, the music data or image data are unlocked (col 20, lines 57-65).

9. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parrella (6,507,764) or Fenner (6,243,328) in view of Hunter (6,647,417) in view of Ansell (6,367,019).

Claim 5, 6 7, 8: Both Parrella and Fenner disclose the system above.

Neither Parrella nor Fenner disclose charging a user after listening to music a predetermined number of times or preventing a user terminal from playing copied music or encryption with a password for unlocking the content.

However, Hunter further discloses that said advertising message or advertising image is automatically separated from said specific musical piece or specific image after said music data or image data have been played predetermined times (col 8, lines 30-35).

Hunter discloses that advertising and music can be downloaded to the user terminal (col 13, line 54-col 14, line 5). Hunter further implies that after purchase the advertisement is separated from the music content and discloses that the music is permanently recorded (col 13, line 63- col 14, line 1). Hunter further discloses that the information for payment can be sent upon listener listening to the music a preset number of times (col 8, lines 30-36).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hunter's separating the music from the advertisement upon user payment to Hunter's charging the user upon the user listening to the content a predetermined number of times. One would have been motivated to do this in order to allow users an appropriate amount of previews before charging the user for permanently owning the music.

Hunter further implies that the intermediate content with advertising can be transferred or copied between user terminals (col 13, lines 60-col 14, line 5). Since Hunter's users can readily copy or transfer content between user terminals, it would be obvious to Hunter that the users can

readily copy or transfer the promotional content that includes the advertisement between user terminals.

Additionally, Ansell discloses making content unplayable when content is copied or transferred from one user terminal to another user terminal (col 5, lines 39-46; col 8, lines 19-30; Fig. 6, Fig. 7).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ansell's making the content unplayable when an illegal copy is performed to Hunter's attempting to prevent illegal copying. One would have been motivated to do this in order to allow Hunter a further method of preventing illegal copying of content.

However, Hunter discloses that said music data or image data are transferred or copied from said user terminal to another terminal, they are locked so that they cannot be played, and by entering a predetermined password transmitted from the advertisement distribution system on a predetermined condition, the music data or image data are unlocked (col 20, lines 57-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hunter's password for unlocking download content to Parrella's or Fenner's downloaded content. One would have been motivated to do this in order to deter illegal copying of Parrella's or Fenner's downloaded content.

Hunter further discloses that the predetermined condition can be that the satellite receivers be customers or some other condition (col 20, lines 60-65; col 7, lines 37-44), that the transmission means, acquisition method, and position of the user are known (col 6, lines 30-60; Fig. 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hunter's download acquisition information to Parrella's or Fenner's downloaded content. One would have been motivated to do this in order to allow Parrella's or Fenner's to download content from different types of sources.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Lowe (6,298,218) discloses combining advertising and content information in downloads.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

AD

1/23/04

Arthur Duran